PATENT
Ser. No. 09/699,609

REMARKS

Reconsideration and allowance of the application in view of the remarks to follow are respectfully requested. Claims 1-21 are pending in this application of which Claims 1, 11 and 18-21 are independent claims. Claims 1, 18 and 20 have been amended above.

Turning to the Office Action, independent Claims 1, 11 and 18-21 were rejected under 35 U.S.C. §112(¶1) as purportedly "contain[ing] subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains... to make and/or use the invention". (Office Action, ¶2) In particular, the Office Action states that "[t]he language 'said document before and after the compressing step is in a given file format', cannot be enabled since the compressing of data, in itself, is the changing of a particular format". (Id.) The Office Action further states that "Applicant indicates in the specification that the term 'format' refers to a hierarchical structure and if that is the case, some clarification is needed in the claim language as oppose[d] to the general term 'format'". (Id.)

First, it is noted that while the claims recite a document comprised of data elements and tag elements that impose a hierarchical structure on the data elements, nowhere does the

8

specification state or imply that the term "format" generally refers to a hierarchical structure.

It is respectfully submitted that the Examiner's focus on the position that the compression of data in itself is the changing of a particular format fundamentally overlooks the clear understanding one skilled in the art would have of the Claim 1 recitation "wherein said document before and after the compressing step is in a given file format". The "format" of data is related to how data is arranged in a particular file, storage device, etc. "Data compression", on the other hand, relates to the reduction of bits, bytes, etc. needed to represent data. Thus, one skilled in the art would readily understand the above-quoted recitation to include use of a compression algorithm to reduce the number of bytes of data within a file or document without altering the arrangement of the data in the file, for example.[1]

That one skilled in the art would clearly and definitely understand the recitation at issue is actually demonstrated by the Hind patent cited in the current Office Action: The Hind background section refers to efforts to compress XML files using binary compression algorithms, which results in a "compressed XML file".

---

[1] There are instances in the art where a format conversion results in reduced file size and is also referred to as "compression". However, the claims are directed at those compression algorithms where the document before and after compression is in the same file format.

9

(Hind, col. 3, lines 24-48) Applicants have noted on the record

that the Claim 1 recitation "wherein said document before and after

the compressing step is in a given file format" clearly means that

after compression the file is in the same format in a compressed

state. (Appeal Brief, fn. 9) The language and embodiments of the

invention given in the specification are consistent with the clear

and definite understanding one would have of this recitation.

E.g., specification, page 5, lines 20-25, and Fig. 2E.

Accordingly, it is respectfully submitted that the Claim 1

recitation "wherein said document before and after the compressing

step is in a given file format" is clear and definite.[2] Claims 11

and 18-21 have identical or like recitation in this regard, and are

likewise clear and definite. Furthermore, the specification

provides ample enabling disclosure for the pertinent claim

---

[2] The Examiner has provided no evidence that one skilled in the art would
necessarily consider compression to result in a change of format, or,
more importantly, that the recitation at issue is unclear. Even assuming
arguendo (but not conceding) that some might view compression as
technically changing to a compressed version of the format, such
practitioners would nonetheless understand this to be the same format in
a compressed state, and encompassed by the recitation at issue.

10

recitations.[3]   (For example, without limiting the scope of the claims, pages 6-7 of the specification describes an exemplary embodiment using the WinZip compression algorithm for compressing the data fields of an XML document into a compressed XML document.) Reconsideration and withdrawal of the rejections of Claims 1, 11 and 18-21 under Section 112 is respectfully requested.

Claims 1-6, 9-15 and 18-21 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,635,088 B1 to Hind, et al.   (Office Action, ¶4)   Claims 7-8 and 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hind in view of U.S. Patent No. 6,175,820 B1 to Dietz.   (Office Action, ¶6)

Focusing first on the rejection of independent Claim 1, the Office Action points to col. 13, lines 20-49 of Hind as purportedly showing "compressing only said data elements in said document using a compression algorithm".   (Office Action, ¶4 at p. 3)   However, the material cited from Hind actually shows compression of the tags of an XML document.   Thus, the Office Action fails to present a

---

[3] It is also submitted that the issue raised by the Examiner appears to be related to indefiniteness, not enablement. In support of this observation, it is noted that paragraph 2 of the Office Action states that "clarification" of the claim language is needed. The Examiner's position is based on the premise that compression necessarily changes the format, whereas, as noted above, Applicants contend that the recitation "said document before and after the compressing step is in a given file format" is adequately clear and definite. Moreover, as discussed above, the recitation is unquestionably enabled by the specification. Thus, the rejection revolves around the meaning and clarity of the selected recitations, not whether the recitations are enabled.

11

prima facie case of anticipation based on the cited aspects of Hind.

Although not cited in the Office Action, it is noted that one aspect of Hind provides compression of XML files in a manner that does not require decompression software. (Hind, col. 3, lines 24-59) The "first aspect" of Hind describes use of the "entity declaration" feature of XML (or like SGML files) to reduce file size. (Hind, col. 8, line 19, et seq.) Under particular circumstances where a reduction in size would result, an entity declaration is created for a particular character string and the character string is replaced with an entity reference. Thus, compression in Hind's first aspect is limited and specifically directed at employment of highly specific processing features of XML itself. In order to further clarify the distinction between Claim 1 and the first aspect of Hind, Claim 1 has been amended above to recite that a compression algorithm "that has a corresponding decompression facet" is used to compress the data elements. Support is found, for example, in the specification at page 7, lines 9-11.

Based on at least the above reasons, Claim 1 is patentably distinct from Hind. Claims 18 and 20 have been amended in like manner as Claim 1 and are distinguishable from Hind for at least analogous reasons. In addition, Claims 11, 19 and 21 include the
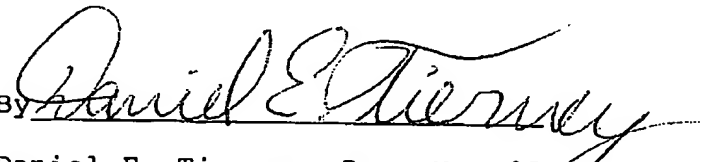
12

recitation relating to an "identifier" of the compression algorithm; such an identifier is not found in the specific data reduction method of Hind, which utilizes XML processing features. For at least this reason, Claims 11, 19 and 21 are patentably distinct from Hind. Reconsideration and allowance of independent Claims 1, 11 and 18-21 is respectfully requested.

As noted, dependent Claims 2-6, 9, 10 and 12-15 were rejected as anticipated by Hind, and dependent Claims 7, 8, 16 and 17 were rejected as obvious over Hind in view of Dietz. Dietz does not include any teachings which may be used to cure the deficiencies of Hind, noted above. Thus, without conceding the patentablility per se of dependent Claims 2-10 and 12-17, they are allowable at least by virtue of their dependencies on their respective independent claim. Accordingly, reconsideration and allowance of all claims in the Application, namely, Claims 1-21, is respectfully requested.

The Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited. Early and favorable action is earnestly solicited.

Respectfully submitted,

By

Daniel E. Tierney, Reg. No. 33,461
631-588-4429

13